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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,243	11/21/2001	Jonathan Phillips	32064-5	2400

7590

02/28/2003

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EXAMINER

PHILOGENE, PEDRO

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 02/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/990,243

Applicant(s)

PHILLIPS, JONATHAN

Examiner

Pedro Philogene

Art Unit

3732

-- Th MAILING DATE of this communication appears on th cover sheet with the correspond nce address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 05. 6) ☐ Other:

***Claim Rejections - 35 USC § 102***

**I. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**II. Claims 1-8,10-15,18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kyle et al. (5,034,013).**

With respect to claim 1, Kyle et al disclose an intramedullary nail (10) comprising an elongated, integral device having a widened distal section (13) adjacent and in spaced relation from the distal end and a widened proximal section (11) adjacent a proximal end, each widened section having hole (15,21) therethrough generally normal to a longitudinal axis of the nail for receiving an anchoring member, as set forth in column 3, lines 36-41.

With respect to claims 2-8,18, Kyle et al discloses all of the limitations as set forth.

With respect to claims 10-15, 19-20, the method steps as set forth would have been inherently carried out in the operation of the device, as set forth above.

***Claim Rejections - 35 USC § 103***

**III. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**IV. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kyle et al (5,034,013) in view of Ross (5,019,079).**

With respect to claim 9, it is noted that Kyle did not specifically teach of a nail with an anchoring screw having distal and proximal threaded end and central unthreaded portion; as claimed by applicant. However, in a similar art, Ross evidences the use of a screw with such characteristics to provide lateral stability for the bone screw and maximize the thread surface area through which the compressive forces are applied to the bone fragments.

Therefore, given the teaching of Ross, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the screw of Ross in the device of Kyle et al. to provide lateral stability for the bone screw and maximize the thread surface area through which the compressive forces are applied to the bone fragments.

Claims 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kyle et al (5,034,013) in view of Freeland (4,862,883).

With respect to claims 16,17, although Kyle et al teach of a bend at least at one of the proximal and distal sections at an angle relative to the central section; as best seen in FIGS. 9-11; it is noted that kyle et al did not teach of a bending device as claimed by applicant. However, in a similar art, Freeland evidences (FIGS.19-21) the use of a bending device as taught by applicant, capable of bending the intramedullary nail of Kyle et al to allow improved revascularization about the nail.

Therefore, given the teaching of Freeland, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the bending device of Freeland to bend the intramedullary nail of Kyle et al to allow improved revascularization about the nail.

### ***Conclusion***

#### **V. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.**

4,913,137	4-1990	Azer et al.
5,041,115	8-1991	Frigg et al.
5,035,697	7-1991	Frigg
5,484,438	1-1996	Pennig

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (703) 308-2252. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P Shaver can be reached on (703) 308-2582. The fax phone

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numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 305-3591 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Pedro Philogene  
February 25, 2003



**PEDRO PHILOGENE**  
**PRIMARY EXAMINER**